

ESTTA Tracking number: **ESTTA746411**

Filing date: **05/13/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218280
Party	Defendant Ibrahim Dabes dba Dabes Egyptian Imports
Correspondence Address	John E. Lord One LLP 9301 Wilshire Boulevard, Penthouse Suite Beverly Hills, CA 90210 UNITED STATES jlord@onellp.com, crodriguez@onellp.com, info@onellp.com
Submission	Other Motions/Papers
Filer's Name	John E. Lord
Filer's e-mail	jlord@onellp.com, avradenburgh@onellp.com, smessina@onellp.com
Signature	/s/John E. Lord
Date	05/13/2016
Attachments	Dabes.MOT to Vacate Order and to Reopen Time to respond to MOT to Stay.pdf(1999812 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL
BOARD**

Mya Saray, LLC,)	
)	
Opposer/Petitioner/Plaintiff,)	
)	Application Serial No. 86/025,182
)	Reg. No. 4536391
)	
)	Proceeding No.: 91218280
)	Cancellation No: 92060249
)	
Dabes, Ibrahim DBA)	
Dabes Egyptian Imports,)	
)	
Applicant/Respondent/Defendant.))	

**MOTION TO VACATE ORDER SUSPENDING PROCEEDINGS PENDING CIVIL
LITIGATION AND TO REOPEN THE TIME TO OPPOSE MOTION TO SUSPEND
PROCEEDINGS**

Pursuant to Trademark Rule 2.127(b), TBMP § 509.01(b)(1), and Federal Rule of Civil Procedure 60(b), Applicant/Respondent Ibrahim Dabes (“Dabes”) hereby moves the Board to vacate its May 2, 2016 order suspending these proceedings and to reopen the time for Dabes to file a memorandum in opposition to Opposer/Petitioner Mya Saray’s (“Mya” or “Petitioner”) motion to suspend proceedings pending civil litigation. As support for this motion, Dabes would show as follows:

STATEMENT OF FACTS

1. The present trademark dispute between Dabes and Petitioner involves two related proceedings - an Opposition proceeding No. 91218280 and Cancellation No. 92060249. Both proceedings involve the same parties and substantially similar issues. (Declaration of John E. Lord (“Lord Decl.”), ¶ 3, attached hereto and incorporated herein as Exhibit “A”). Indeed, given the substantial similarities between the two proceedings, the Board, *sua sponte* ordered the consolidation of the two proceedings on October 27, 2015.

2. Dabes' affirmative defenses in the dispute include, among others, that (1) Petitioner has not plead any law or facts that justify the refusal of its application or cancellation of Dabes' mark, and consequently, Petitioner has failed to state a claim upon which relief can be granted, (2) Dabes' mark is not likely to cause confusion, to cause mistake or deception with the marks allegedly owned by Petitioner. Dabes' affirmative defense cites to a prior November 21, 2013, Office Action where the Trademark Examining Attorney assigned to the subject application, Serial No. 86/025,182, found, after searching the registered and pending marks, no likelihood of confusion and found "no conflicting marks that would bar registration under Trademark Act Section 2(d)." Lord Decl., Ex. B.

3. On January 20, 2016, Petitioner filed a complaint in the United States District Court for the Eastern District of Virginia against Dabes and other defendants for trademark infringement and other related claims (the "Virginia Action"). Lord Decl., Ex. C. As of the date of filing of this motion, Petitioner has not served Dabes with process in the Virginia action.

4. On March 23, 2016, Petitioner filed a Motion to Suspend Proceedings pending the Virginia Action. This was the first instance in which Dabes became aware of the pending Federal litigation.

5. At the time Petitioner filed its Motion to Suspend, the expert disclosures due date had passed, and discovery was set to close on March 28, 2016. The current trial schedule for this proceeding is attached to the Lord Decl., Ex. D.

6. On April 7, 2016, both Petitioner and Dabes filed a consented motion for extension of time to respond to Petitioner's Motion to Suspend.

7. During this time, Dabes was in the process of securing new counsel for the TTAB proceeding. As of May 9, 2016, new counsel had been retained. Lord Decl., ¶2.

8. Had Dabes secured counsel prior to the extended response date, a timely response would have been filed or a request for extension of an adequate time would have

been filed.

ARGUMENT

I. THE BOARD SHOULD VACATE THE ORDER SUSPENDING PROCEEDINGS PENDING CIVIL LITIGATION AND REOPEN THE TIME TO OPPOSE MOTION TO SUSPEND PROCEEDINGS.

Trademark Rule 2.127(b) provides a party thirty days from the date of an order of the Board to seek reconsideration or modification of the order. In addition, TBMP § 509.01(b)(1) provides for reopening the time for filing a brief in opposition to a motion upon a showing of excusable neglect. “The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party’s omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith.” TBMP § 509.01(b)(1). In this instance, these factors weigh in favor of relief.

First, prejudice on Petitioner is minimal and Dabes will suffer severe prejudice. “The ‘prejudice to the nonmovant’ contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant’s previous failure to take timely action, and more than the nonmovant’s loss of any tactical advantage which it otherwise would enjoy as a result of the movant’s delay or omission. Rather, ‘prejudice to the nonmovant’ is prejudice to the nonmovant’s ability to litigate the case, e.g., where the movant’s delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant.” *Id.*

Here, this proceeding is in its late stages. Discovery has been exchanged, and at the time of filing the Motion to Suspend, a mere five (5) days remained in the discovery period, suggesting that the filing of the Federal proceeding was tactical to avoid the trial period and a decision on the merits of the present proceeding. Indeed, all that is left is for the parties to proceed to trial. How the TTAB rules will have persuasive, and perhaps determinative, effect on the Virginia action and could save both parties the time and expense of starting a new litigation in Virginia over very similar claims. Dabes will suffer serious prejudice should the TTAB not allow briefing on the Motion to Suspend because it will have had to defend itself the past few years in the TTAB against Petitioner, and then have to start over and defend itself – at great expense – all over again in the Virginia action, which could last more than two years.

Second, the length of the delay is minimal because the action has already been stayed and Dabes is amenable to expedited briefing on the reopening of the Motion to Suspend. Further, Dabes request to reopen time to respond is made less than one month from the extended deadline to file a response to the Motion to Suspend.

The Board has found the third factor – the reason for the delay -- to be of paramount importance.” *FirstHealth of The Carolinas, Inc. v. Carefirst of Maryland, Inc.*, 479 F.3d 825, 829 (Fed. Cir. 2007). *See also PolyJohn Enterprises Corp. v. 1-800-Toilets, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002); *Atlanta-Fulton County Zoo, Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (“dominant factor” is reason for the delay). Here, the reason for the delay is based on substitution of counsel necessitated by the incredibly late filing of the federal action, and not on inattention to the proceeding or a tactical one. During the briefing of the Motion to Suspend, as set forth in the Consented Motion for Extension of Time, due to the newly filed federal action so late in the proceedings, Dabes believed it was now necessary to seek new counsel; more specifically, litigation counsel. Because Dabes was seeking litigation counsel, Dabes’ counsel of record was requested to take no action in anticipation of litigation counsel being secured. Although Dabes did

secure new counsel, it unfortunately occurred after the deadline to respond, and since being engaged, new counsel has diligently attended to this matter. The decision to change counsel was not a delay tactic, but rather a necessary one in light of the federal litigation action that had been filed so incredibly late in these proceedings.

Dabes has acted in good faith. The issue was not a tactic used for delay, strategic advantage, or any other improper purpose. Lord Decl., ¶ 8. In this instance, the reasons for granting relief therefore far outweigh the reasons for refusing it. Indeed, as discussed above, in light of the extraordinarily late filing of the federal action, the opportunity to keep this well-advanced proceeding before the Board, so as to obtain a decision on the merits, far outweighs any reasons for denying reopening the time to allow Dabes to respond. In addition, Rule 60(b) provides for relief from an order not only for “excusable neglect” but also for mistake or inadvertence. Fed. R. Civ. P. 60(b)(1). Accordingly, if it is deemed that the failure to timely file the response was due to mistake or inadvertence because of the counsel substitution, respectfully Dabes contends that the mistake should be excused as Dabes has diligently prosecuted this matter, and had not displayed indifference or inattention to this matter. Therefore, Dabes respectfully requests the Board vacate its order suspending this proceeding.

II. THE BOARD SHOULD REOPEN THE TIME TO OPPOSE MOTION TO SUSPEND PROCEEDINGS

Dabes believes it has demonstrated excusable neglect. The need to provide adequate time for a party to obtain counsel, and for counsel to become sufficiently familiar with a matter to give informed advice, provides at least excusable neglect. Undersigned counsel were only recently retained, and as a result, respectfully request an opportunity to oppose Petitioner’s Motion to Suspend.

CONCLUSION

For all of these reasons, Dabes respectfully requests that the Board vacate its order suspending proceedings pending civil litigation and reopen the time for Dabes to file a memorandum in opposition to Petitioner's motion to suspend proceedings pending civil litigation.

Respectfully submitted,

Date: May 13, 2016

/ John E. Lord /

John E. Lord

Attorney for Applicant
ONE LLP
9301 Wilshire Boulevard
Penthouse Suite
Beverly Hills, CA 90210
Ph: 310-866-5157
Fax: 310-943-2085
Email: jlord@onellp.com

CERTIFICATE OF SERVICE

I hereby certify that on May 13, 2016, I caused a true and correct copy of the foregoing MOTION TO VACATE ORDER SUSPENDING PROCEEDINGS PENDING CIVIL LITIGATION AND TO REOPEN THE TIME TO OPPOSE MOTION TO SUSPEND PROCEEDINGS to be served on the attorney for the Petitioner, as designated below, by United States Mail, first class, postage prepaid, addressed as follows:

M. Keith Blankenship, Esq.
Da Vinci's Notebook, LLC
10302 Bristow Center Dr. #52
Bristow, VA 20136
Ph: (703) 646-1406
keith@dnotebook.com

/John E. Lord /

John E. Lord

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL
BOARD**

Mya Saray, LLC,)	
)	
Opposer/Petitioner/Plaintiff,)	
)	Application Serial No. 86/025,182
)	Reg. No. 4536391
)	
)	Proceeding No.: 91218280
)	Cancellation No: 92060249
)	
Dabes, Ibrahim DBA)	
Dabes Egyptian Imports,)	
)	
Applicant/Respondent/Defendant.))	

DECLARATION OF JOHN LORD

I, John E. Lord, declare and state as follows:

1. I am an attorney and have been retained to represent Applicant/Respondent Ibrahim Dabes (“Dabes”) in the above-captioned proceeding. I make this declaration based upon my own personal knowledge.
2. I have been retained as counsel for Dabes as of May 9, 2016.
3. The present trademark dispute between Dabes and Petitioner involves two related proceedings - an Opposition proceeding No. 91218280 and Cancellation No. 92060249 that has been consolidated. Both proceedings involve the same parties and substantially similar issues.
4. Attached as Exhibit B is a true and correct copy of the November 21, 2013, United States Patent and Trademark Office Office Action regarding Serial No. 86/025,182.
5. Attached as Exhibit C is a true and correct copy of the complaint filed in *Mya Saray, LLC v. Dabes, Ibrahim dba Dabes Egyptian Imports, et al*, Civil Action No. 1:16-cv-00064-LMB-IDD, dated January 20, 2016 in the United States District Court for

the Eastern District of Virginia.

6. Attached as Exhibit D at page 10 is a true and correct copy of the Trademark Trial and Appeal Board's Trial Schedule for these consolidated proceedings.

7. At the time Petitioner filed its Motion to Suspend, the expert disclosures due date had passed, and discovery was set to close on March 28, 2016.

8. The filing of the Motion to Vacate Order Suspending Proceedings Pending Civil Litigation and to Reopen the Time to Oppose the Motion to Suspend Proceedings is not a tactic used for delay, strategic advantage, or any other improper purpose.

Respectfully submitted,

Date: May 13, 2016

/ John E. Lord /

John E. Lord

Attorney for Applicant
ONE LLP
9301 Wilshire Boulevard
Penthouse Suite
Beverly Hills, CA 90210
Ph: 310-866-5157
Fax: 310-943-2085
Email: jlord@onellp.com

EXHIBIT B

To: Dabes, Ibrahim (tmiami@fggbb.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86025122 - AMY DELUXE - 7400-T13-409
Sent: 11/21/2013 3:54:37 PM
Sent As: ECOM104@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86025122

MARK: AMY DELUXE

86025122

CORRESPONDENT ADDRESS:

PAUL D. BIANCO
FLEIT GIBBONS GUTMAN BONGINI & BIANCO

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

PL

21355 E DIXIE HWY STE 115
MIAMI, FL 33180-1244

APPLICANT: Dabes, Ibrahim

CORRESPONDENT'S REFERENCE/DOCKET NO :

7400-T13-409

CORRESPONDENT E-MAIL ADDRESS:

tmiami@fggbb.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: **11/21/2013**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

NO LIKELIHOOD OF CONFUSION FOUND

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

TRANSLATION OF FOREIGN REGISTRATION REQUIRED

The applicant must submit an English translation of the foreign registration. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

PLEASE NOTE – Until a translation is provided, the examining attorney is unable to determine if the foreign registration contains a color claim. Since the foreign registration copy is not in color, it is impossible to tell. Accordingly, the examining attorney must presume that the mark in the foreign registration is in black and white. Thus, the following requirement is raised:

MARK DIFFERS ON FOREIGN REGISTRATION – MARK NOT IN COLOR

The drawing of the mark in the U.S. application is not acceptable because it does not correspond to the mark shown in the foreign registration. *See* 15 U.S.C. §1126(e); 37 C.F.R. §2.51(c). Specifically, the drawing in the U.S. application displays the mark in color and includes a color claim, but the foreign registration does not show the mark in color or otherwise indicate that particular colors are claimed as a feature of the mark.

The drawing of a mark in a U.S. application must be a substantially exact representation of the mark that appears in the foreign registration. 37 C.F.R. §2.51(c); *In re Hacot-Colombier*, 105 F.3d 616, 618-19, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997); TMEP §§807.07(b), 1011.01; *see United Rum Merchs. Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481 (TTAB 1988). If the foreign registration includes a color claim, the U.S. application must include the same color claim; if the foreign registration does not include a color claim, the U.S. application may not contain a color claim. *See* TMEP §§807.07(d)(ii), 1011.01.

Therefore, applicant must clarify whether the foreign registration includes the same color claim set forth in the U.S. application by satisfying one of the following:

- (1) If the foreign registration does not include a color claim or its legal equivalent, applicant must submit: (a) a new black-and-white drawing of the mark for the U.S. application that conforms to the mark shown in the foreign registration and which does not otherwise materially alter the mark in the U.S. application (amending the drawing of the mark in the U.S. application to agree with the mark in the foreign registration would not be considered a material alteration of the mark in this case); (b) a statement that color is not claimed as a feature of the mark in the U.S. application and deleting any color claim; and (c) an amended mark description that accurately describes all literal and design elements of the applied-for mark but does not reference color. *See* 37 C.F.R. §§2.37, 2.52(b)(1), 2.72(c); TMEP §§807.07(a)(i)-(b), 807.12(b), 1011.01.; or
- (2) If the foreign registration includes a color claim or the legal equivalent, applicant must provide a statement to that effect, specifying the colors claimed and describing where they appear in the mark in the foreign registration. *See* TMEP §§807.07(b), 1011.01. Applicant must also submit a color photocopy of the foreign registration. TMEP §1011.01. If the foreign registration is not issued in color, applicant must provide evidence establishing that (a) the colors shown in the mark in the U.S. drawing are the same colors claimed in the foreign registration, and (b) the colors appear in the same locations within the mark in the U.S. drawing and foreign registration. *See*

TMEP §§807.12(b), 1011.01. Such evidence may include a written statement from the intellectual property office of the foreign country that indicates the colors claimed and their location in the mark in the foreign registration. The color claims and mark descriptions in both the U.S. application and foreign registration must agree. *See* TMEP §§807.07(d)(ii), 1011.01.

If applicant cannot satisfy the above requirements, and the application currently also contains a Trademark Act Section 1 filing basis, applicant may respond by deleting the Section 44 basis from the application and proceeding solely on the Section 1 basis. *See* 15 U.S.C. §§1051(a)-(b), 1126(d)-(e); 37 C.F.R. §2.35(b)(1); TMEP §806.04. A foreign registration certificate is not required for a Section 1(a) or 1(b) basis. *See* 15 U.S.C. §1051(a)-(b); TMEP §806.01(a)-(b). If the application is currently based solely on Section 44, applicant may amend the basis from Section 44 to Section 1(a) or 1(b), if applicant can satisfy the requirements for the chosen basis. *See* 15 U.S.C. §§1051(a)-(b), 1126(e); 37 C.F.R. §2.35(b)(1); TMEP §806.03.

IDENTIFICATION OF GOODS

The identification of goods includes “smoking articles,” which is the heading of International Class 34. The purpose of such class headings is to indicate the subject matter and general scope of each international class of goods. *See* TMEP §1401.02(a). While such broad designations may be acceptable under the trademark laws and practice of other countries, the USPTO considers these headings too broad to identify goods in a U.S. application. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1297-99 (TTAB 1986), *rev’d on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); TMEP §§1401.08, 1402.01 *et seq.*, 1402.07(a).

An identification of goods in a U.S. application must be specific, definite, clear, accurate, and concise. TMEP §1402.01; *see In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d at 1298-99. Identifications may be amended only to clarify or limit the goods and/or services, adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.* The scope of the identification for purposes of permissible amendments to class headings is limited by both the ordinary meaning of the words in and the international class of the heading. *See* TMEP §§1402.06(a), (b), 1402.07(a).

Therefore, applicant must amend the class heading to identify goods that fall within (1) the ordinary meaning of the words specified in the class heading, and (2) the international classification of the heading. *See* TMEP §§1402.06(a), (b), 1402.07(a).

Applicant may adopt the following identification of goods, if accurate:

International Class 34 – “Tobacco; smoking articles, namely, {please indicate the type of goods, e.g. cigarettes, cigars, smoking pipes, etc.}”

For assistance with identifying and classifying goods in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

DISCLAIMER

Applicant must disclaim the descriptive wording “DELUXE” apart from the mark as shown because it merely describes a feature of applicant’s goods. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS*

Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); TMEP §§1213, 1213.03(a).

Specifically, terms “that are merely laudatory and descriptive of the alleged merit of a product are . . . regarded as being descriptive” because “[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1256, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); TMEP §1209.03(k). In fact, “puffing, if anything, is *more* likely to render a mark merely descriptive, not less so.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d at 1256, 103 USPQ2d at 1759.

The term “DELUXE” means “high or highest in quality.” See attached dictionary evidence. Because the term “DELUXE” attributes quality, it is laudatory, and thus merely descriptive of the goods.

A “disclaimer” is a statement in the application record that applicant does not claim exclusive rights to an unregistrable component of a mark; a disclaimer of unregistrable matter does not affect the appearance of the mark or physically remove disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive or generic of an applicant’s goods. 15 U.S.C. §1052(e); see TMEP §§1209.03(f), 1213.03 *et seq.* Such words need to be freely available for other businesses to market comparable goods or services and should not become the proprietary domain of any one party. See *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use “DELUXE” apart from the mark as shown.

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

/Jason Paul Blair/
Examining Attorney
Law Office 104
Phone - (571) 272-8856
Fax - (571) 273-8856

jason.blair@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**



All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

DictionaryThesaurusWord DynamoQuotesReferenceTranslatorSpanishLog InSign UpPremium

deluxe

Related Searches

- Print shop deluxe d...
- Deluxe checks
- Ham radio deluxe s...
- Free printshop softw...
- Free download for a ...
- Zuma deluxe
- Free downloads prin...
- Nero photoshow del...

Nearby Words

-
- delusterant
 - delustering
 - delustrant
 - deluxe**
 - delvaux
 - delvaux, paul
 - delve
-

Synonyms

- first-class
- exquisite
- luxurious
- exclusive
- expensive
- sumptuous
- luscious



6601 BACKLICK RD SPRINGFIELD, VA 22150
Visit website or call 800.338.0813




\$19,255!

The New 2014 Volkswagen PassatSee Current Incentives & Sel

deluxe   Use Deluxe in a sentence

Order Checks Online
www.checksinthemail.com/
New Customers Get 1 Box for \$6.99. Get 2 Boxes for \$11.99. Order Now!

Deluxe for Business
www.deluxe.com/
Printed Checks for Small Business. \$50 Off Orders Over \$200 - Shop Now

de-luxe  [duh-luhks, -loo ks]  Show IPA

adjective

- of special elegance, sumptuousness, or fineness; **high or highest in quality**, luxury, etc.: *a deluxe hotel; a deluxe edition of Shakespeare bound in leather.*

adverb

- in a luxurious or sumptuous manner: *We always travel deluxe.*

Also, **de luxe**.

Origin:

1810-20; < French *de luxe* of luxury

Related forms

su-per-de-luxe, adjective

Dictionary.com Unabridged
Based on the Random House Dictionary, © Random House, Inc., 2013.
[Cite This Source](#) | [Link To deluxe](#)

Example sentences

The base model comes sans air conditioning and power windows, but those

Some have those special annexed sun rooms that are part of the **deluxe** line.

And returns based on the **deluxe** model had a positive skew: large windfalls were

Long waits have always been part of the experience of acquiring a **deluxe** custom

 EXPAND



moto x

Your phone. Your style.
\$99.99

Back



Accent



Design Yours

USCIOUS

► MORE



Your style.
Your phone.
\$99.99

Design Yours



Word Origin & History

Etymonline

deluxe

1819, from Fr. de luxe, lit. "of luxury," from L. luxus "excess, abundance."

Online Etymology Dictionary, © 2010 Douglas Harper

[Cite This Source](#)

Relevant Questions

[What Is Turbo Tax Deluxe?](#) [How To Play Piano Deluxe](#) [How To Update Quicken](#)
[How To Troubleshoot A Delu](#)[How To Find A Deluxe Cinema](#)[What Is Turbotax Deluxe](#)



Enjoy Dictionary.com ad-free! [Learn more](#)

Related Words

day coach	ouncer
epicurean	standard
luxe	superliner
ouncer	► MORE

Matching Quote

*"And if so
(And science ought to know)
We well may raise our heads
From weeding garden beds
And annotating books
To watch this end **deluxe**."*

-Robert Frost

[► MORE](#)



com, LLC. All rights reserved.

[About](#) | [PRIVACY POLICY](#) | [Terms](#) | [Careers](#) | [Advertise with Us](#) | [Contact Us](#) | [Suggest a Word](#) | [Help](#)

To: Dabes, Ibrahim (tmmiami@fggbb.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86025122 - AMY DELUXE - 7400-T13-409
Sent: 11/21/2013 3:54:38 PM
Sent As: ECOM104@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **11/21/2013** FOR U.S. APPLICATION SERIAL NO. 86025122

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **11/21/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

EXHIBIT C

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

MYA SARAY, LLC

Plaintiff

v.

DABES, IBRAHIM dba
DABES EGYPTIAN IMPORTS

and

PREMIUM MOLASSES, INC.

and

SHISHA WHOLESALERS, INC.

and

WORLD SMOKE SHOP

Defendants

Docket No.

1:16cv64
LMB/IDD

2016 JAN 20 A 11:19
CLERK US DISTRICT COURT
ALEXANDRIA, VIRGINIA

FILED

JURY TRIAL DEMANDED

COMPLAINT

Mya Saray, LLC for its complaint against Ibrahim Dabes, Premium Molasses, Inc., Shisha Wholesalers, Inc., and World Smoke Shop avers with knowledge as to its own acts and otherwise on information and belief as follows:

THE PARTIES

1. The Plaintiff Mya Saray, LLC ("Mya Saray") is a limited liability company organized and existing under the laws of the Commonwealth of Virginia, with its principal place of business at 6405 10th Street, Alexandria, VA.

2. Defendant Ibrahim Dabes, dba Dabes Egyptian Imports, (“Dabes”) is a sole proprietorship, with a mailing address of Neuburger Str. 109 Augsburg; Fed Rep Germany 86167.

3. Defendant Premium Molasses, Inc. (“Premium Molasses”) is an Illinois corporation, with a principal place of business at 1056 East Wilson Ave; Lombard, IL 60148. The registered agent for Premium Molasses is Luai Abuhilal accepting service at 75 Eisenhower Lane South; Lombard, IL 60148.

4. Defendant Shisha Wholesalers, Inc. (“Shisha Wholesalers”) is an Illinois corporation, with a principal place of business at 75 Eisenhower Lane South; Lombard, IL 60148. The registered agent for Shisha Wholesalers is Luai Abuhilal accepting service at 75 Eisenhower Lane South; Lombard, IL 60148.

5. Defendant World Smoke Shop (“World Smoke Shop”) is a California sole proprietorship doing business at 508 South Brookhurst St.; Anaheim, CA 92804.

JURISDICTION AND VENUE

6. This civil action for unfair competition arises under the Patent laws of the United States, including 35 U.S.C. §271, the Unfair Competition laws of the United States, including 15 U.S.C. § 1125; and the Virginia Consumer Protection Act (“VCPA”), Va. Code § 59.1-196 et seq. This court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(b), and supplemental jurisdiction for VCPA claims pursuant to 28 U.S.C. § 1367(a). Venue is proper under 28 U.S.C. §§ 1391(b) and 1400(b). Ibrahim Dabes, Premium Molasses, Inc., Shisha Wholesalers, Inc., and World

Smoke Shop (collectively, “Defendants”) are subject to personal jurisdiction in this district.

FACTS

7. Mya Saray is a manufacturer and distributor of tobacco products, particularly hookahs and hookah accessories, and has been in existence since 1863.

8. Mya Saray sells tobacco products nationally under the federally registered trademarks MYA, Reg. No. 3,031,439 (“the ‘439 registration” or the “Mya Word Mark”) and MYA (as stylized), Reg. No. 3,031,440 (“the ‘440 registration” or the “Mya Design Mark”), and Reg. No. 4,693,443 (“the ‘443 registration”). True copies of the ‘439 registration and the ‘440 registration and the ‘443 registration are attached hereto as Exhibit A and Exhibit B and Exhibit C, respectively. Mya Saray owns many common law trademarks incorporating the term MYA having rights derived from the ‘439 and ‘440 registrations, including MYA (and depictions thereof) on packaging, advertisements, hookahs, etc.

9. Mya Saray is the exclusive owner of United States Patent No. 8,001,978 (“the ‘978 patent”) with authority to enforce that patent. A true copy of the ‘978 patent is attached as Exhibit D.

10. Mya Saray manufactures, distributes, advertises, publicizes, sells, and offers to sell the Mya QT hookah (“QT”), depicted in Exhibit E. The QT product design (“QT Hookah”) is distinctive, non-functional, and serves as a trademark. Furthermore, the QT Hookah is composed of a distinctive hookah stem design (“QT Stem”) and a distinctive hookah base (“QT Base”), each separately trademarked and capable of

independently acting as an indicator of source. The base of the QT hookah is protected by U.S. Trademark Reg. No. 3,845,276 (“the ‘276 registration”). Exhibit E.

11. The MYA brand is one of the most counterfeited brands in the world.

12. Dabes is a German industrialist that has been importing hookahs from third party manufacturers for resale in Europe.

13. Mya Saray first encountered Dabes on or about 2009 when Dabes requested authority to distribute Mya Saray hookahs throughout Europe.

14. In performing due diligence, Mya Saray uncovered that Dabes was involved in significant counterfeiting activities, including offering counterfeits of multiple Mya Saray hookahs. Mya Saray refused Dabes distribution rights in any territory.

15. Subsequent to Mya Saray’s refusal of Dabes’ attempted distribution rights, Dabes began to sell hookahs throughout Europe with the term “AMY” associated therewith. The term “AMY” was stamped upon hookahs and hookah cases, and portrayed in advertisement and sales media for Dabes’ hookahs (“AMY hookahs”).

16. On or about July 31, 2013 Dabes filed an application in the U.S. Patent and Trademark Office for registration of a logo comprising the term “AMY DELUXE” as a logo, U.S. App. Ser. No. 86,025,122 (“the ‘122 application”).

17. On or about July 31, 2013 Dabes filed an application in the U.S. Patent and Trademark Office for registration of a logo comprising the term “AMY GOLD TOBACCO MOLASSES” as a logo, U.S. App. Ser. No. 86, 025,182 (“the ‘182 application”).

18. Dabes exports into the United States its AMY hookahs to two national distributors, Premium Molasses and World Smoke Shop. Premium Molasses and Shisha Wholesalers act in unison to accept imported AMY hookahs and distribute them to retail stores throughout the United States.

19. Defendants sell, offer to sell, and use in the United States a counterfeit of Mya Saray's QT hookah that infringes Mya Saray's '978 patent rights and the '276 registration. See Exhibit F.

20. Defendants provide AMY hookahs to Internet retailers in the United States that sell and offer to sell AMY hookahs into this district via website shopping carts, including: http://5starhookah.com/AMY_c200.htm; <http://www.smoking-hookah.com/hookahs>; <http://www.texashookah.com/hookahs.html>; <http://www.smokyhookah.com/hookahs.html>; et. al.

21. Multiple retail stores in this district sell, offer to sell, and use AMY hookahs.

CLAIMS FOR RELIEF

Count I. Violation of 15 U.S.C. § 1125(a)

Unfair Competition and Deceptive Marketing

22. Mya Saray incorporates by reference the preceding paragraphs of this Complaint as though fully set forth herein.

23. The conduct of Defendants constitutes use in commerce of designations and dress, false designations of origin, false or misleading descriptions of fact, and false or misleading representations of fact likely to confuse and deceive a substantial number of distributors in the trade, relevant consumers, and other purchasers as to the affiliation,

connection, or association of Defendants with Mya Saray and others, in violation of 15 U.S.C. § 1125(a)(1)(A).

24. The conduct of Defendants constitutes use in commerce of designations and dress, false designations of origin, false or misleading descriptions of fact, and false or misleading representations of fact likely to confuse and deceive a substantial number of distributors in the trade, relevant consumers, and other purchasers as to the origin, sponsorship, or approval of Defendants' goods and commercial activities as they relate to Mya Saray and others, in violation of 15 U.S.C. § 1125(a)(1)(A).

25. The conduct of Defendants constitutes use in commerce of designations and dress, false designations of origin, false or misleading descriptions of fact, and false or misleading representations of fact that in commercial advertising and promotion misrepresent the nature, characteristics, and qualities of Defendants' goods and commercial activities in violation of 15 U.S.C. § 1125(a)(1)(B).

26. The conduct of Defendants in unfairly competing with Mya Saray is willful and deliberate and done with an intent to misrepresent the nature, characteristics, and qualities of Defendants' goods, and confuse, mislead, and deceive a substantial number of distributors in the trade, relevant consumers, and other purchasers, and members of the public as to the origin of Defendants' goods and to cause said persons to believe that the goods have been sponsored, approved, authorized, or licensed by Mya Saray.

27. Defendants' conduct is causing Mya Saray immediate and irreparable injury and will continue to both damage Mya Saray and deceive the public unless enjoined by this court. Mya Saray has no adequate remedy at law.

**Count II. Violation of 15 U.S.C. § 1114
Registered Trademark Infringement of the '439 Registration**

28. Mya Saray incorporates herein by reference all preceding allegations of this Complaint as though fully set forth herein.

29. The conduct of Defendants in using the MYA Word Mark and colorable imitations thereof in connection with the sale, offering for sale, distribution, and advertising of tobacco products is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(a).

30. The conduct of Defendants in reproducing the MYA Word Mark and colorable imitations thereof and applying the reproduction to labels, signs, prints, packages, wrappers, receptacles or advertisements with the intent to be used in commerce with the sale, offer for sale, distribution, and advertising of tobacco products and such use is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(b).

31. Defendants' conduct is causing Mya Saray immediate and irreparable injury and will continue to both damage Mya Saray and deceive the public unless enjoined by this court. Mya Saray has no adequate remedy at law.

**Count III. Violation of 15 U.S.C. § 1114
Registered Trademark Infringement of the '440 Registration**

32. Mya Saray incorporates herein by reference all preceding allegations of this Complaint as though fully set forth herein.

33. The conduct of Defendants in using the MYA Design Mark and colorable imitations thereof in connection with the sale, offering for sale, distribution, and

advertising of tobacco products is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(a).

34. The conduct of Defendants in reproducing the MYA Design Mark and colorable imitations thereof and applying the reproduction to labels, signs, prints, packages, wrappers, receptacles or advertisements with the intent to be used in commerce with the sale, offer for sale, distribution, and advertising of tobacco products and such use is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(b).

35. Defendants' conduct is causing Mya Saray immediate and irreparable injury and will continue to both damage Mya Saray and deceive the public unless enjoined by this court. Mya Saray has no adequate remedy at law.

**Count IV. Violation of 15 U.S.C. § 1114
Registered Trademark Infringement of the '276 Registration**

36. Mya Saray incorporates herein by reference all preceding allegations of this Complaint as though fully set forth herein.

37. The conduct of Defendants in using the QT hookah product design and colorable imitations thereof in connection with the sale, offering for sale, distribution, and advertising of tobacco products is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(a).

38. The conduct of Defendants in reproducing the QT hookah product design and colorable imitations thereof and applying the reproduction to labels, signs, prints, packages, wrappers, receptacles or advertisements with the intent to be used in commerce with the sale, offer for sale, distribution, and advertising of tobacco products and such use

is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(b).

39. Defendants' conduct is causing Mya Saray immediate and irreparable injury and will continue to both damage Mya Saray and deceive the public unless enjoined by this court. Mya Saray has no adequate remedy at law.

**Count V. Violation of 15 U.S.C. § 1114
Registered Trademark Infringement of the '443 Registration**

40. Mya Saray incorporates herein by reference all preceding allegations of this Complaint as though fully set forth herein.

41. The conduct of Defendants in using the MYA logo of the '443 registration and colorable imitations thereof in connection with the sale, offering for sale, distribution, and advertising of tobacco products is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(a).

42. The conduct of Defendants in in using the MYA logo of the '443 registration and colorable imitations thereof and applying the reproduction to labels, signs, prints, packages, wrappers, receptacles or advertisements with the intent to be used in commerce with the sale, offer for sale, distribution, and advertising of tobacco products and such use is likely to cause confusion or mistake or to deceive in violation of 15 U.S.C. § 1114(1)(b).

43. Defendants' conduct is causing Mya Saray immediate and irreparable injury and will continue to both damage Mya Saray and deceive the public unless enjoined by this court. Mya Saray has no adequate remedy at law.

**Count V. Patent Infringement
Infringement of the '978 Patent**

44. Mya Saray incorporates herein by reference all preceding allegations of this Complaint as though fully set forth herein.

45. The '978 patent, which was duly and lawfully granted on August 23, 2011, describes and claims a smoking apparatus.

46. Defendants have been and are infringing, inducing infringement of, and contributing to the infringement of the '978 patent by making, using, offering for sale and/or selling, in these United States, or importing into these United States articles, including the AMY "Jinn" hookah, that read on the '978 patent claims, all without the consent of Mya Saray.

47. Mya Saray has been and will continue to be damaged by the infringing activities of Defendants and will be irreparably harmed unless those infringing activities are enjoined by this Court.

**Count VI. Violation of Va. Code § 59.1-200(A)
The Virginia Consumer Protection Act**

48. Mya Saray incorporates herein by reference all other allegations of this Complaint as though fully set forth herein.

49. Defendants are misrepresenting to consumers, and contributing to the ability of other suppliers to misrepresent, that the goods of Defendants are the goods of Mya Saray in violation of Va. Code § 59.1-200(A)(1).

50. Defendants are misrepresenting to consumers, and contributing to the ability of other suppliers to misrepresent, that the goods of Defendants are sponsored by,

approved by, or certified by Mya Saray, or that Mya Saray is a source of such goods in violation of Va. Code § 59.1-200(A)(2).

51. Defendants are misrepresenting to consumers, and contributing to the ability of other suppliers to misrepresent, that their goods are affiliated, connected, or associated with Mya Saray in violation of Va. Code § 59.1-200(A)(3).

52. Defendants are misrepresenting to consumers, and contributing to the ability of other suppliers to misrepresent, that their goods have the characteristics and benefits of the goods of Mya Saray in violation of Va. Code § 59.1-200(A)(5).

53. Defendants are misrepresenting to consumers, and contributing to the ability of other suppliers to misrepresent, that their goods are similar to those of Mya Saray in terms of standards, quality, grade, style, or model in violation of Va. Code Ann § 59.1-200(A)(6).

54. Defendants are violating Va. Code § 59.1-200(A)(14).

WHEREFORE, Plaintiff prays for judgment:

A. That Mya Saray is the owner of U.S. Patent No. 8,001,978 and has the right to sue and collect damages for any and all infringements thereof;

B That U.S. Patent No. 8,001,978 remains good and valid in law and has been infringed by Defendants;

C. That Defendants, and their officers, agents, servants, and employees and those persons in active concert and participation with or controlled by any of them, be preliminarily and permanently enjoined and restrained from infringing, inducing infringement of, and contributing to the infringement of U.S. Patent No. 8,001,978;

D. That Mya Saray is the sole and exclusive owner of the Trademarks referenced in this Complaint, including: the MYA word mark; the MYA design mark (As Stylized); the trade dress for the designs of the QT hookah base, hookah stems, and combination thereof; and that Mya Saray has the right to sue for its damages for any and all infringements thereof and trespasses thereupon;

E. That Defendants have unfairly competed with Mya Saray in violation of the unfair competition laws of Virginia and these United States, including 15 U.S.C. § 1125(a) and the Virginia Consumer Protection Act;

F. That this Court order Defendants, their agents, associates, employees, attorneys, and any other person in active concert or participation with them, be forthwith preliminarily and permanently enjoined from: using, alone or in combination, the designations MYA and MYA (As Stylized) and MYA (as portrayed in the '443 registration) and hookah products having a design confusingly similar to that of any protectable Mya Saray trade dress, including the '276 registration;

G. That Mya Saray be awarded all damages related to the unlawful actions of Defendants as characterized by this Complaint, or in the alternative statutory damages as recoverable under the U.S. Lanham Act.

H. That Defendants be required to account for and to disgorge its profits and that Mya Saray be awarded its damages and that those damages be trebled, together with interest and costs;

I. That Mya Saray be awarded its reasonable attorney's fees and costs in this action;

J. That all infringing articles and all means of making the same be delivered up and destroyed, at the costs of the Defendants;

K. That this Court order the cancellation of any trademark rights recognized by the U.S. Patent and trademark office for any name, symbol, or device utilized by Defendants confusingly similar to any protectable trademark of Mya Saray, including Dabes' U.S. Trademark Application Serial Nos. 86/025,182 and 86/025,122.

L. That Mya Saray be awarded such further relief as this Court may deem just and proper.

JURY DEMAND

Mya Saray demands a trial by jury pursuant to Fed. R. Civ. Pro. 38 as to all issues triable of right to a jury.

DATED: January 19, 2016

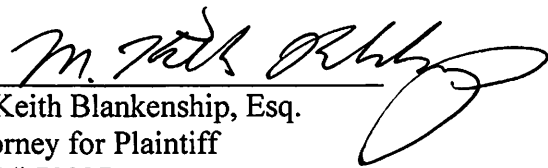
By 
M. Keith Blankenship, Esq.
Attorney for Plaintiff
VSB# 70027
Da Vinci's Notebook, LLC
10302 Bristow Center Dr
No. 52
Bristow, VA 20136
703-581-9562
keith@dnotebook.com

Exhibit A

Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

Reg. No. 3,031,439

United States Patent and Trademark Office

Registered Dec. 20, 2005

**TRADEMARK
PRINCIPAL REGISTER**

MYA

**MYA SARAY, LLC (VIRGINIA LIMITED LIABILITY CORPORATION)
SUITE 1414 EAST
3709 SOUTH GEORGE MASON DRIVE
FALLS CHURCH, VA 22041**

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

**FOR: WATER PIPES FOR SMOKING, IN CLASS 34
(U.S. CLS. 2, 8, 9 AND 17).**

SER. NO. 78-349,755, FILED 1-9-2004.

FIRST USE 3-1-2002; IN COMMERCE 3-1-2002.

ANN E. SAPPENFIELD, EXAMINING ATTORNEY

The '439 Registration – Mya Word Mark

Exhibit B

Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

United States Patent and Trademark Office

Reg. No. 3,031,440

Registered Dec. 20, 2005

**TRADEMARK
PRINCIPAL REGISTER**



**MYA SARAY, LLC (VIRGINIA LIMITED LIABILITY CORPORATION)
SUITE 1414 EAST
3709 SOUTH GEORGE MASON DRIVE
FALLS CHURCH, VA 22041**

**FOR: WATER PIPES FOR SMOKING, IN CLASS 34
(U.S. CLS. 2, 8, 9 AND 17).**

FIRST USE 3-1-2002; IN COMMERCE 3-1-2002.

**THE MARK CONSISTS OF THE NAME MYA IN
STYLIZED FORM.**

SER. NO. 78-349,903, FILED 1-9-2004.

ANN E. SAPPENFIELD, EXAMINING ATTORNEY

The '440 Registration – Mya Design Mark

Exhibit C

United States of America
United States Patent and Trademark Office



Reg. No. 4,693,443

Registered Feb. 24, 2015

Int. Cl.: 34

TRADEMARK

PRINCIPAL REGISTER

MYA SARAY, LLC (VIRGINIA LIMITED LIABILITY COMPANY)

UNIT 114
43671 TRADE CENTER PLACE
STERLING, VA 20166

FOR: TOBACCO PRODUCTS, NAMELY, HOOKAHS AND HOOKAH ACCESSORIES, NAMELY, HOOKAH STEMS, HOOKAH BASES, HOOKAH TONGS, HOOKAH PLATES, HOOKAH BOWLS, HOOKAH HOSES, HOOKAH CASES, AND HOOKAH GROMMETS; TOBACCO SUBSTITUTE; HERBS FOR SMOKING, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 11-20-2014; IN COMMERCE 11-20-2014.

THE MARK CONSISTS OF AN INDEPENDENT ARRANGEMENT OF THE LETTER "M" AND "Y" AND "A" ENCAPSULATED BY A SQUARE, CIRCLE, AND SQUARE, RESPECTIVELY.

SN 86-230,745, FILED 3-24-2014.

JUSTINE D. PARKER, EXAMINING ATTORNEY



Michelle K. Lin
Deputy Director of the United States
Patent and Trademark Office

The '443 Registration – A Mya Logo

Exhibit D

The '978 Patent

(Begins on Next Page)



US008001978B2

(12) **United States Patent**
Mehio

(10) **Patent No.:** **US 8,001,978 B2**
(45) **Date of Patent:** ***Aug. 23, 2011**

(54) **SMOKING APPARATUS**

(56) **References Cited**

(75) **Inventor:** **Nizar Youssef Mehio, Tallet El Khayet (LB)**

(73) **Assignee:** **Mya Saray, LLC, Sterling, VA (US)**

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 190 days.

This patent is subject to a terminal disclaimer.

(21) **Appl. No.:** **11/201,289**

(22) **Filed:** **Aug. 11, 2005**

(65) **Prior Publication Data**

US 2006/0272658 A1 Dec. 7, 2006

(51) **Int. Cl.**
A24F 1/14 (2006.01)
A24F 1/30 (2006.01)

(52) **U.S. Cl.** 131/173; 131/221; 131/229; 131/201;
131/207

(58) **Field of Classification Search** 131/173
See application file for complete search history.

U.S. PATENT DOCUMENTS

722,405 A *	3/1903	Ganim	131/173
3,805,806 A *	4/1974	Grihalva	131/173
3,918,464 A *	11/1975	Kolodziej	131/173
4,134,410 A *	1/1979	Kahler	131/173
5,908,531 A *	6/1999	Laurent	156/396

FOREIGN PATENT DOCUMENTS

DE 2004134 U1 * 5/2000

* cited by examiner

Primary Examiner — Richard Crispino

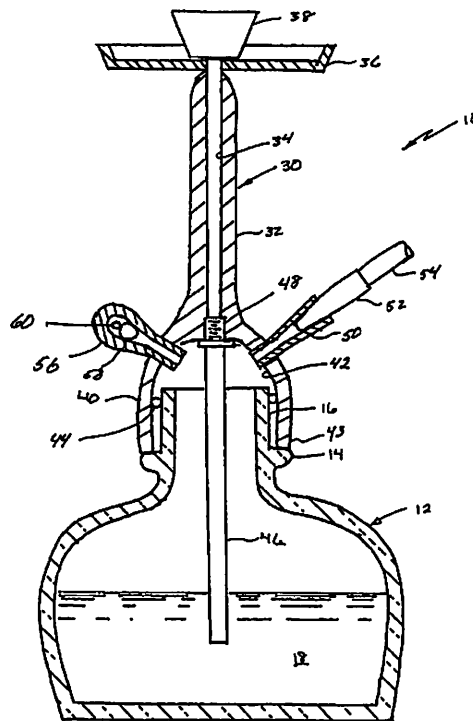
Assistant Examiner — Phu Nguyen

(74) *Attorney, Agent, or Firm* — General Counsel, P.C.

(57) **ABSTRACT**

An improved smoking apparatus includes a bottle containing a fluid. The bottle has an upstanding neck with peripheral collar formed around the external periphery thereof. A stem has a base and a neck. The base defines an interior plenum, and a passage extends through the neck and terminates at the interior passage. A burner cup is mounted to the stem in communication with the passage. The interior plenum has a size and shape to permit the stem to be coupled to the bottle by placing the base over the neck, with a bottom edge of the base resting on the collar of the bottle. A sealing element is disposed between the exterior surface of the neck of the bottle and the inner surface of the interior plenum to provide a substantially air-tight coupling.

14 Claims, 1 Drawing Sheet



U.S. Patent

Aug. 23, 2011

US 8,001,978 B2

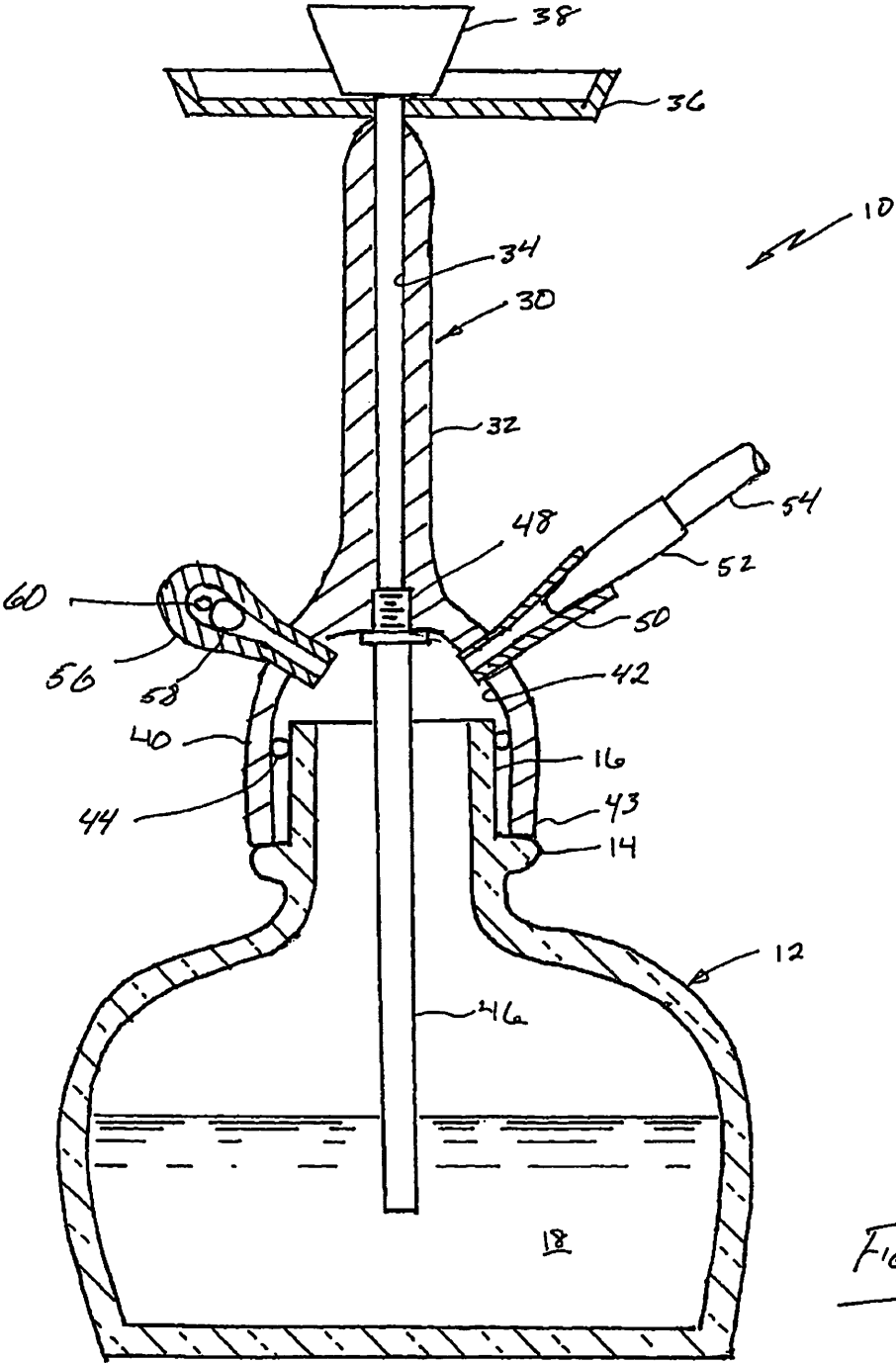


FIG. 1

US 8,001,978 B2

1

SMOKING APPARATUS

BACKGROUND OF THE INVENTION

1. Field of the Invention

The invention relates to smoking apparatuses, such as a pipe, and more particularly to smoking pipes with blown-glass bases.

2. Description of the Related Art

Pipes are often used to smoke substances such as tobacco. Moisture from a fluid may be mixed with pipe smoke to ameliorate harshness and to impart a pleasant flavor or aroma to the smoke. So-called hookah pipes are one way in which smoke may be mixed with moisture.

A hookah pipe has a bottle which filled with fluid. The bottle of the hookah may be made of glass, such as crystal. A stem is mounted to the bottle. The stem includes a passage conveying smoke from a burner cup on top of the stem through a down tube projecting from the stem and into the fluid in the bottle. The stem is preferably made of metal. The smoke drawn through the stem is expelled from the down tube beneath the surface of the fluid and allowed to bubble up through the fluid to the surface, absorbing moisture as it rises to the fluid surface. The stem base defines an interior plenum into which smoke bubbling from the fluid surface collects. One or more smoking hoses are connected to the stem, in communication with the interior plenum. A user smokes the hookah by drawing smoke through the hose.

The bottle of a hubble-bubble is often made of blown glass. The stem of the hookah is mounted to a neck of the base, so the neck must be drawn out to a length and diameter commensurate with the dimensions of the metal stem and plenum during the glass blowing process. It may be difficult to control accurately the dimensions of the neck while the glass is being blown. Some of this variation of dimensions is attractive, and lends a unique, hand-crafted appearance to the base. Significant variations of dimensions can make coupling the stem to the neck with an air tight connection difficult. Typically a base of the stem is inserted or threaded into the neck of the bottle. The stem must fit inside the neck substantially tightly in order to prevent smoke from leaking. The longer the neck, the more likely the inner profile of the neck will vary from true roundness, and the less likely the stem will fit tightly.

SUMMARY OF THE INVENTION

The current invention is embodied in a smoking apparatus which includes a bottle containing a fluid, a stem coupled to the bottle, and one or more smoking tubes connected to the stem which permit users to draw smoke from a burner cup mounted to the stem, through the stem and the fluid contained within the bottle, and out of the tube.

The bottle has an upwardly-extending neck and a radially extending collar extending around the external periphery of the neck. The stem has a base and a neck extending upwardly from the base. The base defines an interior plenum having a size and shape that permits the base to be placed over the neck of the bottle with a bottom edge of the base resting on the collar.

BRIEF DESCRIPTION OF THE OF THE DRAWINGS

FIG. 1 is a smoking pipe according to the present invention shown in cross section.

2

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS

A smoking apparatus in the form of a hookah pipe indicated by reference no. 10 is shown in FIG. 1. The pipe 10 includes a bottle 12 containing a liquid 18 and a stem 30 mounted to the top of the bottle 12. The bottle 12 has an upper, generally cylindrical neck 16 and a radially extending peripheral shoulder 14 surrounding the neck beneath the upper end thereof. The bottle 12 may be formed from any suitable material such as glass, plastic, acrylic, ceramic, etc.

The stem 30 includes an upper neck 32 and a stem base 40. A burner cup 38 for holding the smoking material, such as tobacco, is mounted proximate a top end of the neck 32. Preferably a plate 36 is positioned beneath the burner cup 38 for catching ashes and other materials spilled from the burner cup 38.

The stem base 40 forms an interior plenum 42. The lower portion 43 of the base 40 has a shape, preferably circular, that conforms to the shape of the neck 16 of the bottle 12 and has a diameter sufficiently larger than that of the neck 16 so that the stem 30 can be operatively mounted onto the bottle 12 by merely placing the stem base 40 over the neck 16 so that the lower end 43 of the stem base 40 is seated on the collar 14 of the bottle 12. Preferably, a sealing element, such as o-ring 44 or other suitable gasket material, is placed over the neck 16 between the neck 16 and the inner surface of the stem base 40 to provide a generally airtight seal between the stem base 40 and the neck 16.

A passage 34 extends from the burner cup 38 through the neck 32. A down tube 46 is secured into the neck 32, preferably by a threaded end 48, in alignment with the passage 34. The down tube 46 extends from the interior plenum 42 into the bottle 12 such that its lower-most end is beneath the surface of the liquid 18.

A hose fitting 50 extends into the stem base 40 and is preferably threaded thereto. A smoking hose 54 has a hose nipple 52 secured at an end thereof, and the nipple 52 is secured to the hose fitting 50 by forcing its tapered end into the tapered opening of the hose fitting as shown in FIG. 1.

The pipe 10 is smoked by a user drawing smoke through a mouthpiece (not shown) at an opposite end of the hose 54, thereby drawing air through the burner cup 38, through the passage 34 and down tube 46, through the liquid 18, up into the interior plenum 42, and through the hose fitting 50 and hose 54. Although not shown, the pipe 10 may include more than one hose fitting and attached hoses to permit multiple users.

Because the stem 30 is coupled to the bottle 12 by merely placing the stem base 40 over the neck 16 with o-ring 44 in place to provide a suitable seal, manufacturing tolerances of the neck 16 need not be so stringent. In addition, should the bottle 12 be broken, the stem 30 can easily be placed onto a second bottle having a neck of generally similar proportions.

A pressure release 56 extends into the stem base 40 and is preferably secured thereto by threading. The pressure release comprises a generally enclosed tab with an interior plenum including a tapered portion and a rounded end portion. A ball 58 is disposed within the interior of the pressure release 56 and a relief opening 60 is formed in the pressure release 56 into the interior portion thereof. During use of the pipe while a user is drawing smoke through the tube 54, the relative vacuum formed in the interior plenum 42 draws the ball 58 into the tapered portion of the interior plenum of the pressure release 56, thereby blocking any air passage through the pressure release 56. To equalize the pressure within the interior plenum 42 of the stem 30, the user need only blow slightly

US 8,001,978 B2

3

into the tube 54. The increased pressure created within the interior plenum 42 will cause the ball 58 to dislodge from the tapered portion thereby permitting airflow into the pressure release 56, around the ball 58, and out of the relief opening 60.

While various embodiments of the present invention have been described above, they should be understood to have been presented by way of examples only, and not limitation. Thus, the breadth and scope of the present invention should not be limited by the above described embodiments.

Modifications and variations of the present invention are possible in light of the above teachings. It is therefore to be understood that the invention may be practiced otherwise than as specifically described herein.

What is claimed is:

1. A hookah system comprising:

a hookah bottle having an upper neck with a substantially flush exterior, peripheral side surface and a hookah bottle opening;

a flexible seal disposed about said substantially flush exterior, peripheral side surface; and

a hookah stem with a stem base defining an interior plenum comprising:

an interior sidewall having a substantially flush sidewall surface dimensioned to sealingly accept said flexible seal by compressing said flexible seal upon said substantially flush exterior, peripheral side surface of said neck upon placement of said stem onto said bottle neck;

an elevated wet smoke cavern above said hookah bottle opening and defined by said interior sidewall positioned above said compressed flexible seal for the direct accumulation of wet smoke from said bottle; and

a wet smoke aperture defined by said interior plenum sidewall that directly accesses said wet smoke cavern and is adapted to accept a hose fitting.

2. The system of claim 1 wherein said flexible seal is removably disposed about the periphery of said neck.

3. The system of claim 1 wherein said wet smoke cavern includes a perimeter diminishing upwardly with respect to said bottle.

4. The system of claim 3 wherein said stem further comprises multiple wet smoke outlets, and multiple hose fittings in fluid communication with said multiple wet smoke outlet such that each wet smoke outlet allows the passage of wet smoke to a single hose fitting.

5. The system of claim 4 wherein said multiple hose fittings are removable hose fittings with a threaded portion.

6. The system of claim 1 wherein said bottle further defines a peripheral shoulder dimensioned to support said hookah stem.

4

7. The system of claim 1 further comprising a down tube, connected to said interior sidewall, passing through said wet smoke cavern and descending into said bottle.

8. The system of claim 7 wherein said down tube is releasably connected to said interior sidewall.

9. A hookah system comprising:

a hookah bottle having an upper neck with a substantially flush exterior, peripheral side surface, an interior side surface, and a hookah bottle opening;

a flexible seal disposed about said substantially flush exterior, peripheral side surface; and

a hookah stem with a stem base defining an interior plenum comprising:

an interior plenum sidewall having a substantially flush sidewall surface dimensioned to sealingly accept said flexible seal by compressing said flexible seal upon said substantially flush exterior, peripheral side surface of said neck upon placement of said stem onto said bottle neck;

an elevated wet smoke cavern above said hookah bottle opening and defined by said interior plenum sidewall positioned above said compressed flexible seal for the direct accumulation of wet smoke from said bottle; and

a wet smoke aperture defined by said interior plenum sidewall that directly accesses said wet smoke cavern and is adapted to accept a hose fitting; and

a down tube, connected to said interior plenum sidewall, with a down tube exterior and passing through said wet smoke cavern and descending into said bottle,

wherein space between said down tube and said interior plenum sidewall and space between said down tube and said inside neck surface define a substantially annular wet smoke ascension void, extending continuously from said bottle into said wet smoke cavern, positioned to allow the uniform, direct ascension of wet smoke from said bottle to said wet smoke cavern.

10. The system of claim 9 wherein said flexible seal is removably disposed about the periphery of said neck.

11. The system of claim 9 wherein said wet smoke cavern includes a perimeter diminishing upwardly with respect to said bottle.

12. The system of claim 11 wherein said stem further comprises multiple wet smoke outlets, and multiple hose fittings in fluid communication with said multiple wet smoke outlet such that each wet smoke outlet allows the passage of wet smoke to a single hose fitting.

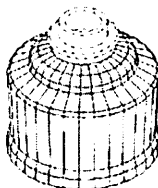
13. The system of claim 12 wherein said multiple hose fittings are removable hose fittings with a threaded portion.

14. The system of claim 9 wherein said bottle further defines a peripheral shoulder dimensioned to support said hookah stem.

* * * * *

Exhibit E

United States of America
United States Patent and Trademark Office



Reg. No. 3,845,276

Registered Sep. 7, 2010

Int. Cl.: 34

TRADEMARK

PRINCIPAL REGISTER

MYA SARAY, LLC (VIRGINIA LIMITED LIABILITY COMPANY)
UNIT 114
43671 TRADE CENTER PLACE
STERLING, VA 20166

FOR: HOOKAHS, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 11-7-2005, IN COMMERCE 11-7-2005.

THE MARK CONSISTS OF A THREE-DIMENSIONAL CONFIGURATION OF A HOOKAH BASE THAT IS GENERALLY CIRCULAR IN DESIGN AND HAS SEVERAL GRADUATED LEVELS. THE MATERIAL SHOWN IN BROKEN LINES IS NOT PART OF THE MARK.

SEC. 2(F).

SER. NO. 77-959,010, FILED 3-15-2010.

SHARON MEIER, EXAMINING ATTORNEY



The '276 Registration

The MYA QT Hookah



Exhibit F

Name: _____
 Anschrift: _____
 Telefon: _____
 Datum: _____

Dabes Egyptian Imports
 Neuburgerstr. 109
 86167 Augsburg
 Tel: +49 821 5439446

**Preisliste / Bestellformular**

- gilt für Intertabac 2011 -

Wasserpfeifen

DABES HOOKAH

	Jinn		Bestellnr. qt-0003		Preis/ ab 1 Kart.	Preis /3 Kart.
	rot	schwarz				
	grün	amber			13,50 €	12,00 €
	violett	blau				
	Crazy Dots		Bestellnr. id760-1		Preis/ ab 1 Kart.	Preis /3 Kart.
	auch mit Koffer	schwarz			15,00 €	12,50 €
		grün			20,00 €	19,50 €
		amber			(mit Koffer)	(mit Koffer)
	Crazy Dots Special Art		Bestellnr. id760a-1		Preis/ ab 1 Kart.	Preis /3 Kart.
	amber	red white			16,00 €	14,00 €
	blue white	green blue				
	Memory		Bestellnr. id580-1		Preis/ ab 1 Kart.	Preis /3 Kart.
	blue white	blue line			28,00 €	26,00 €
	red white	black green				
	red line					
	Mangia		Bestellnr. id950/id950-2		Preis/ ab 1 Kart.	Preis /3 Kart.
	blau	rot			28,00 €	26,00 €
	schwarz	weiß				
	gelb					
	Joay		Bestellnr. id980		Preis/ ab 1 Kart.	Preis /3 Kart.
		schwarz			28,00 €	26,00 €
		blau				
		rot				
	Jamie		Bestellnr. id990		Preis/ ab 1 Kart.	Preis /3 Kart.
		blau			28,00 €	26,00 €
		braun				
		schwarz				
	Walsh		Bestellnr. egs-0058_n		Preis/ ab 1 Kart.	Preis /3 Kart.
	blau	grün			13,50 €	12,50 €
	schwarz	amber				
	rot					
	Baghira		Bestellnr.		Preis/ ab 1 Kart.	Preis /3 Kart.
	auch mit Koffer					
	silber-blau	kupfer-rot	wp100-1		34,50 €	31,00 €
	silber-grün	kupfer-transparent	wp100-2		37,50 €	34,00 €

Dabes Catalogue Picture

JS 44 (Rev. 12/12)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

I. (a) PLAINTIFFS

MYA SARAY, LLC

DEFENDANTS

Dabes, Ibrahim; Shisha Wholesalers, Inc.; Premium Molasses, Inc.; World Smoke Shop

(b) County of Residence of First Listed Plaintiff Alexandria

(EXCEPT IN U.S. PLAINTIFF CASES)

County of Residence of First Listed Defendant N/A

(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

(c) Attorneys (Firm Name, Address, and Telephone Number)

M. Keith Blankenship, Da Vinci's Notebook, LLC; 10302 Bristow Center Dr. No. 52; Bristow, VA 20136 - 703-581-9562

Attorneys (If Known)

Bianco, Paul D.; Fleit Gibbons Gutman Bongini & Bianco P.L. 21355 E. Dixie Highway, Suite 115, Miami, FL 33180, USA

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excludes Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 362 Personal Injury - Medical Malpractice	PERSONAL INJURY <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 367 Health Care/Pharmaceutical Personal Injury Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157	<input type="checkbox"/> 375 False Claims Act <input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 896 Arbitration <input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision <input type="checkbox"/> 950 Constitutionality of State Statutes
<input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 440 Other Civil Rights <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 448 Education	PRISONER PETITIONS Habeas Corpus: <input type="checkbox"/> 463 Alien Detainee <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty Other: <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 560 Civil Detainee - Conditions of Confinement	<input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Management Relations <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 751 Family and Medical Leave Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Retirement Income Security Act	<input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark	<input type="checkbox"/> 861 HIA (1395f) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g))
			IMMIGRATION <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 465 Other Immigration Actions	FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	

V. ORIGIN (Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from Another District (specify)
- ☐ 6 Multidistrict Litigation

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
15 U.S.C. 1114

Brief description of cause:
Trademark Infringement and Unfair Competition

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER RULE 23, F.R.Cv.P.

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE
 01/20/2016

SIGNATURE OF ATTORNEY OF RECORD

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

Court Name: United States District Court
Division: 1
Receipt Number: 1683056542
Cashier ID: rbroaden
Transaction Date: 01/20/2016
Payer Name: JOHN DOE

CIVIL FILING FEE

For: JOHN DOE

Amount: \$400.00

CREDIT CARD

Amt Tendered: \$400.00

Total Due: \$400.00

Total Tendered: \$400.00

Change Amt: \$0.00

FILING FEE

116CV64

EXHIBIT D

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: October 27, 2015

Opposition No. 91218280 (**Parent Case**)
Cancellation No. 92060249

Mya Saray, LLC

v.

Ibrahim Dabes dba Dabes Egyptian Imports

George C. Pologeorgis,
Interlocutory Attorney:

Consolidation

It has come to the Board's attention that the above-captioned proceedings involve common questions of law and fact and the parties are the same. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also*, *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Accordingly, the Board, *sua sponte*, orders the consolidation of the above-captioned proceedings.

In view thereof, Opposition No. 91218280 and Cancellation No. 92060249 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989)

and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file for these consolidated cases will be maintained in Opposition No. 91218280 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed in the parent case of the consolidated proceedings, but that copy should bear both opposition proceeding numbers in its caption. The only exception is that the answer to each notice of opposition must be filed in the respective corresponding proceeding.

The parties are further advised that despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file.¹

Opposition No. 91218280

Ibrahim Dabes dba Dabes Egyptian Imports ("Applicant") seeks to register the mark AMY GOLD TOBACCO MOLASSES and design, as displayed below, for "tobacco; smoking articles, namely, cigarettes, cigars, smoking pipes, and shishas" in International Class 34.²

¹ The parties should promptly inform the Board in writing of any other related *inter partes* proceedings. See Fed. R. Civ. P. 42(a).

² Application Serial No. 86023182, filed on July 31, 2013, based on a *bona fide* intention to use the mark in commerce under Section 44(e) of the Trademark Act. The terms "TOBACCO" and "MOLASSES" are disclaimed. Applicant's application is based on German Registration No. 302012000345 registered on July 23, 2012.

On January 20, 2015, Applicant filed a motion to amend the identification of goods from the current identification to "tobacco." The Board construed the motion as unconsented and deferred consideration of the motion until final decision or until the case is decided upon summary judgment. See Board order dated May 19, 2015 at 11 TTABUVE.



On September 10, 2014, Mya Saray, LLC (“Opposer”) filed a notice of opposition opposing registration of Applicant’s involved mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. In support of its asserted claim, Opposer has pleaded ownership of the registered marks below used in association with various tobacco products including hookahs and water pipes for smoking:

1. MYA;

2.  ;

3. ECONO-MYA;

4.  ; and

5. 

Opposer’s Motion to Compel in Opposition No. 91218280

This case now comes before the Board for consideration of Opposer’s motion (filed May 28, 2015) to compel written discovery filed in Opposition No. 91218280. The motion is fully briefed.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to Opposer's motion.

Initially, the Board finds that Opposer has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that Opposer's motion is timely. *See* Trademark Rule 2.120(e)(1).

The Board further notes that, in its initial motion papers, Opposer identifies certain discovery requests which are in dispute. In response to Opposer's motion, Applicant maintains that most of Opposer's concerns have been addressed through supplemental responses provided to Opposer concurrently with its response to Opposer's motion, and that the only discovery requests that remain in dispute concern: (1) alternative brand designations, (2) the design differences between Opposer's hookah and Applicant's hookahs, and (3) physical specimens of Applicant's hookahs. In its reply brief, Opposer does not contest that Applicant's supplementation addresses most of its concerns and that the only issues remaining are those identified by Applicant in its response to Opposer's motion to compel. In view of the foregoing and because Opposer failed to identify with specificity which discovery requests remain at issue,³ the Board will entertain Opposer's motion with regard to the discovery requests specifically identified below.

³ In the event that issues raised in a motion to compel are subsequently resolved by the parties, the moving party should inform the Board in writing, filed through ESTTA, of the issues in the motion which no longer require determination. Trademark Rule 2.120(e); TBMP § 523.02 (2015). As noted above, Opposer failed to do so.

Interrogatory Requests

Interrogatory No. 3

If the Defendant utilizes alternative brand designations in connection with Defendant Products, identify such alternative brand designations by its literal elements (e.g. words) and design elements (e.g., illustrated components).

Interrogatory No. 4

Explain other inspiration and meaning of the alternative brand designations responsive to Interrogatory No. 3 how the Products for such other alternative brand designations related to Defendant Products sold under the AMY brand with specific referent to Defendant Product quality, Defendant product quantity (generally at this time), Defendant Product manufacturing source, the characteristics of prospective purchases of the Defendant Products, and other significant criteria.

Motion is **DENIED** with regard to Interrogatory Nos. 3 and 4 since the only mark at issue in this proceeding is Applicant's involved AMY GOLD TOBACCO MOLASSES and design mark. The Board notes that a party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. See TBMP § 414(11) (2015).

Opposer maintains that the above requests are relevant to the issue of Applicant's intent to counterfeit Opposer's goods. The Board notes, however, that Opposer has not asserted claims of unfair competition or trade dress infringement or that Applicant's goods constitute counterfeit goods nor does the Board have jurisdiction to entertain such claims. *See Board of Trustees of University of Alabama v. Pitts*, 107 USPQ2d 2001, 2022 (TTAB 2013) (no jurisdiction to consider questions of infringement or unfair competition); *see also The E.E. Dickinson Co. v. The T.N. Dickenson Company*, 221 USPQ 713, 714 (TTAB 1984) ("...trade dress infringement

and unfair competition are matters which are not within the Board's jurisdiction.”).

The only issue before the Board is whether Applicant's AMY GOLD TOBACCO MOLASSES and design mark, when used in connection with the goods identified in Applicant's subject application, is likely to cause confusion with Opposer's pleaded MYA marks. Accordingly, the Board finds that Opposer has failed to demonstrate the relevance of the information sought in Interrogatory Nos. 3 and 4 to the issues in this proceeding.

Interrogatory No. 14

Identify the individual most knowledgeable about the appearance and aesthetic properties of each hookah identified of Interrogatory No. 8.

Interrogatory No. 33

Describe each product design difference perceptible to Defendant between the Subject Hookah labeled as AMY-018 and the Econo-MYA QT depicted in Exhibit 4.

Interrogatory No. 34

Describe each product design difference perceptible to Defendant between the Subject Hookah labeled as Jinn and the MYA QT depicted in Exhibit 5.

Motion is **DENIED** with regard to Interrogatory Nos. 14, 33 and 34 inasmuch as the appearance of a party's goods is not relevant to the question of likelihood of confusion in an *inter partes* proceeding before the Board. *See Gen. Foods Corp. v. Costa Ice Cream Company*, 165 USPQ 797 (TTAB 1970); *Crawford Fitting Co. v. C.B. Crawford Company*, 135 USPQ 381 (TTAB 1962).

Document Requests

Document Request No. 9

A physical sample of each Subject Hookah.

Motion is **GRANTED** solely to the extent that Applicant must produce a physical sample of the hookahs it intends to sell in the United States, if any currently exist, or currently sells in the United States under its involved AMY GOLD TOBACCO MOLASSES and design mark.

Document Request No. 14

All documents and things that refer or relate to the creation, design, and appearance of the Subject Hookahs, including the creation design and appearance alternatives.

Motion is **DENIED** to the above document request because, as noted above, the appearance of a party's goods is not relevant to the question of likelihood of confusion in an *inter partes* proceeding before the Board. *See Gen. Foods Corp. v. Costa Ice Cream Company*, 165 USPQ 797 (TTAB 1970); *Crawford Fitting Co. v. C.B. Crawford Company*, 135 USPQ 381 (TTAB 1962).

Document Request No. 15

All documents and things that refer or relate to the creation, design, and appearance of the AMY logo, including the creation design and appearance of alternatives.

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents which refer or relate to the creation, design, and appearance of Applicant's involved mark and design, i.e., AMY GOLD TOBACCO MOLASSES and

design. Motion is **DENIED** to the extent that it seeks documents regarding creation design and appearance of alternative logos or marks not at issue in this proceeding.

Document Request No. 16

All documents and things that refer or relate to the creation, design, and appearance of the AMY brand, including the creation, design, and appearance alternatives.

Motion is **DENIED** to the above identified document request. The only mark at issue in this proceeding is Applicant's involved AMY GOLD TOBACCO MOLASSES and design and such information is addressed in Document Request No. 15.

Document Request No. 17

All documents and things relating or referring to design differences between the Subject Hookahs and any Plaintiff hookah.

Motion is **DENIED** with regard to the above-identified document request. As noted above, the appearance of a party's goods is not relevant to the question of likelihood of confusion in an *inter partes* proceeding before the Board.

Summary

As restricted by this order, Opposer's motion to compel is **DENIED** with regard to Interrogatory Nos. 3, 4, 14, 33, and 34 and Document Request Nos. 14, 15 (in part), 16, and 17.⁴ Opposer's motion to compel is **GRANTED** with regard to Document Request No. 9 and with regard to Document Request 15, in part, as set forth below.

⁴ Additionally, for the reasons explained herein, Applicant is not required to respond to any of Opposer's written discovery already propounded in Opposition No. 91218280 that are not specifically identified by this order and which seek information or documents that concern (1) use of Applicant's marks other than Applicants involved AMY GOLD TOBACCO MOLASSES and design mark, (2) the design of Applicant's hookahs, or (3) the differences between the design of Opposer's hookahs

Applicant is also allowed until **thirty (30) days** from the mailing date of this order to copy and to produce non-privileged documents responsive to Opposer's Document Request Nos. **9 and 15**, to the extent set forth by this order.⁵ Applicant must organize and label, by bates stamp number, the documents responsive to each of the above-identified document requests.

If there are no responsive, non-privileged documents in Applicant's possession, custody or control which are responsive to any of the above-identified document requests, Applicant must so state affirmatively in its response to the corresponding document request.

To the extent Applicant has already **fully** produced documents responsive to Document Request Nos. 9 and 15, Applicant must so state in its response to the particular document request and **identify, by bates number, the documents which are responsive to each request.**

Additionally, Applicant is required to provide Opposer a privilege log within the same **thirty (30) days** provided above to the extent that Applicant claims privilege to **any** of Opposer's written discovery requests, if it has not already done so.⁶

In the event Applicant fails to provide Opposer with full and complete responses to the outstanding discovery, as required by this order, Applicant will be barred

⁵ To the extent the production of documents to any of the document requests identified above is voluminous in nature, Applicant may produce a representative sampling of documents responsive to the corresponding document request. Such representative sampling, however, must be sufficient to meet Opposer's discovery needs.

⁶ The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408 (2015). Each party and its attorney have a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.*

from relying upon or later producing documents or facts at trial withheld from such discovery.⁷ *See* Fed. R. Civ. P. 37(c)(1).

Trial Schedule For Consolidated Proceedings

Proceedings in Opposition No. 91218280 are resumed and will proceed as a consolidated case with Cancellation No. 92060249 upon the trial schedule set forth below.

Expert Disclosures Due	2/27/2016
Discovery Closes	3/28/2016
Plaintiff's Pretrial Disclosures	5/12/2016
Plaintiff's 30-day Trial Period Ends	6/26/2016
Defendant's Pretrial Disclosures	7/11/2016
Defendant's 30-day Trial Period Ends	8/25/2016
Plaintiff's Rebuttal Disclosures	9/9/2016
Plaintiff's 15-day Rebuttal Period Ends	10/9/2016

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁷ If Applicant fails to comply with this order, Opposer's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).